

09-21-04

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Docket No. HORWO-P3197

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Tim P. Horwood, et al.

Serial No.: 10/606,605

Art Unit: 3751

Filed: June 26, 2003

Examiner: Phillips, Charles E.

For: PORTABLE SPA

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

**PETITION UNDER 37 C.F.R. § 1.47(a) AND/OR TO ALLOW ONE INVENTOR/ASSIGNEE TO
CONTINUE PROSECUTION**

Sir:

Applicant and joint inventor, Tim P. Horwood hereby petitions the Patent Office to be allowed to continue prosecution of the above-referenced patent application by responding to the Election Requirement dated March 19, 2004. As explained herein and in the other documents contemporaneously being filed by Mr. Horwood, Mr. Horwood has complied with all the requirements of 37 C.F.R. § 1.47(a) and/or has taken all actions reasonably required to be entitled to continue this prosecution.

In any case, Applicant Horwood respectfully submits that, under the circumstances of this application and as described herein, the instant application should not be abandoned but instead should continue with substantive examination and (hopefully) eventual issuance.

The circumstances supporting continued prosecution by Mr. Horwood are at least somewhat reflected in the existing PTO records in this application, and include at least the following:

09/22/2004 SSESHE1 00000055 10606605

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Mark A. Pellegrini, Reg. No. 50,233
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DATE

1. The application for this case is supported by a declaration signed by all three joint inventors.

The present issue therefore relates to continuing prosecution and representation of those inventors, rather than a lack of a signed declaration regarding inventorship and related matters.
2. One of the three joint inventors, John E. Pope, assigned all right title and interest in and to the parent application (09/491,361), as well as any future continuation applications (including the above-identified '605 continuation application), to the other two joint inventors, Mr. Horwood and Keith W. Lovell. That assignment was recorded on January 26, 2000 at Reel/Frame 010553/0625). (Declaration of Tim P. Horwood, Ex. A).
3. Due to a dispute between the two remaining inventors/nominal assignees (Mr. Horwood and Mr. Lovell), their previous counsel (Craig S. Summers of the Knobbe Martens firm) withdrew from representation of Applicants. That withdrawal is reflected in the PTO Notice Regarding Change of Power of Attorney in this application, mailed by the PTO on or about July 14, 2004.
4. Despite Mr. Horwood's efforts to resolve the dispute with joint inventor Lovell, Mr. Lovell has at all times been unwilling to reach any reasonable resolution, and therefore remains effectively unavailable for coordinated representation in this continuing prosecution. Among other things, Mr. Lovell has refused to provide any instructions regarding the pending application.

In support of this petition, the applicants submit the following:

1. Declaration of Tim P. Horwood
2. Petition for Five (5) Months' Extension of Time with required \$1005.00 fee; and
3. The \$130.00 petition fee required under 37 C.F.R. 1.17(h), for the present Petition.

DISCUSSION

Applicant and joint inventor, Tim Horwood, is filing this petition because joint inventor Lovell is refusing to continue participating in the prosecution of this application. Rather than allow the application to go abandoned, Mr. Horwood is asking to be given control to prosecute the application without Mr. Lovell's involvement, or at least to be allowed to keep alive the application so that the opportunity for appropriate patent protection is not lost via abandonment. To date, Mr. Lovell has not responded to communications from Mr. Horwood regarding this issue (see attached Horwood Dec., Exhibit B). Mr. Lovell has been provided with a copy of a proposed Response to the March 19th Election Requirement, but refuses to acknowledge same, or give Mr. Horwood any instructions regarding same.

Since Mr. Lovell is "refusing to participate" in the prosecution, Mr. Horwood is attempting to proceed without Mr. Lovell, rather than allow the application to go abandoned. It appears that 37 C.F.R. § 1.47 may cover or be relevant to this type of situation (at least by analogy). That 37 C.F.R. § 1.47 appears to be directed to situations in which one inventor refuses to sign the Declaration in the original filing of a patent application. In the present '605 application, however, all inventors have signed the Declaration. Applicant respectfully requests that the PTO allow him to proceed without active participation by his joint inventors, as opposed to holding the application to be abandoned.

In this regard, Mr. Lovell and Mr. Horwood entered into an agreement on or about August 8, 1999, regarding the above-referenced portable spa. An informal document regarding that agreement provided that Mr. Lovell and Mr. Horwood have equal ownership of the invention, agree to any changes, decisions, and compensate the other for any time and/or money spent in regard to the invention, and each has the right of first refusal if the other should want to sell his share of the invention. That informal agreement appears to be silent regarding what is to be done if Mr. Lovell and Mr. Horwood are unable of agree on certain issues such as prosecution of the application. No further writings apparently were made to modify that agreement. The parties proceeded with filing a patent application, which issued as U.S.

Pat. No. 6,584,624 on July 1, 2003, and with the present related application. Although Mr. Lovell and Mr. Horwood have subsequently had some verbal discussions and/or agreements regarding various issues, they have reached an impasse as to other issues, leading to the aforementioned withdrawal of Mr. Summers from this application and to the need for this action by Mr. Horwood to keep alive the application. Details of Mr. Horwood's efforts to obtain Mr. Lovell's cooperation are included in other documents filed herewith.

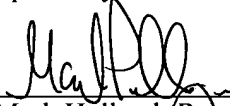
Based on the foregoing, Applicant Horwood respectfully requests that the application be kept "alive" and not abandoned, and that prosecution of the application continue in accordance with the Response to Election Requirement filed herewith.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, or credit any overpayment, to Deposit Account No. 08-2624.

Respectfully submitted,

Date:

Sept 20, 04



J. Mark Holland (Reg. No. 32,416)
Mark A. Pellegrini (Reg. No. 50,233)
J. Mark Holland & Associates,
a Professional Law Corporation
3 Civic Plaza, Suite 210
Newport Beach, California 92660
Telephone: 949-718-6750
PTO Customer Number 21,259

JMH:LMB:mad

Enclosures

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Tim P. Horwood, et al.

Serial No.: 10/606,605

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Filed: June 26, 2003

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For: PORTABLE SPA

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

DECLARATION OF TIM P. HORWOOD

Sir:

The undersigned, being advised that willful false statements and the like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application (or document) or any resulting registration, hereby states the following:

1. My name is Tim P. Horwood. I am a joint inventor of the above-identified patent application, filed under U.S. App. No. 10/606,605, along with Keith W. Lovell and John E. Pope.
2. The above-identified patent application is a continuation of U.S. Patent Application Ser. No. 10/137,929 filed May 2, 2002 (which issued as U.S. Patent No. 6,584,624 on or about July 1, 2003) (the '929 application). That '929 application was a

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Mark A. Pellegrini, Reg. No. 50,233
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Sept 20, 04
DATE

continuation of U.S. Patent Application Ser. No. 09/491,361, which was filed on or about January 26, 2000 (and which is now abandoned) (the '361 application).

3. In that first '361 application, Mr. Pope assigned all right, title and interest in and to the '361 application, as well as any future continuation applications, to Mr. Lovell and myself. That assignment was recorded on or about January 26, 2000 at Reel/Frame 010553/0625). A true and correct copy of that Assignment is attached hereto as Exhibit A.
4. After that January 2000 filing of the original '361 application, Mr. Lovell and I proceeded with prosecution of that application and the related continuation '929 application (including through issuance of that '929 application in July 2003), as well as the June 2003 filing of the current related/pending '605 application. Since approximately August 2003, however, Mr. Lovell and I no longer maintain a cordial relationship due to, among other things, a disagreement regarding maintenance of that issued U.S. Patent No. 6,584,624 (from the '929 application) and prosecution of this further continuation application (the '605 application).
5. Since those disagreements arose, both Mr. Lovell and I directly, and the attorney (Craig Summers) who had been representing Mr. Lovell and me in connection with the '624 patent (issued from the '929 application), made repeated various efforts to resolve those disagreements. Following the PTO's Election Requirement (dated March 19, 2004), our previous attorney Mr. Summers advised that he could not continue representing both Mr. Lovell and me in this application, because of those disagreements and the apparent/actual conflict of interest they caused. Consequently, Mr. Summers withdrew as our attorney in connection with this application, which withdrawal I understand was effective just a few weeks ago, on or about July 2004. I understand

that Mr. Lovell is aware of all of the foregoing facts, including the withdrawal by Mr. Summers.

6. In view of the foregoing, I have retained another firm, J. Mark Holland & Associates, regarding the conflict between Mr. Lovell and me and specifically in order to prevent the pending '605 application from going abandoned.
7. Mr. Lovell is married to my sister, and the disagreement has affected communications within and among our family. Mr. Lovell has made it clear to me that he and his wife (my sister) do not want to see me, and he has stated that he would try to physically harm me if I came by to see him. Notwithstanding those threats, I made numerous attempts to discuss and resolve the matter with Mr. Lovell through our attorney, Craig Summers. When those attempts were not successful, on or about September 10, 2004 I wrote a letter to Mr. Lovell confirming my understanding of the status of the March 2004 Election Requirement and the response deadline of September 19, 2004 in relation thereto. A true and correct copy of that correspondence is attached as Exhibit B.
8. As shown in Exhibit B, I sent that letter to the last known address I have for Mr. Lovell, namely: 8 Navajo Trail, Phillips Ranch, California 91766. In view of the short time remaining before the deadline for response, I caused that letter to be sent to Mr. Lovell by both facsimile and hand delivery. Regarding that hand delivery, one of my employees, Nicholas F. Peloso, delivered the letter by hand to Mr. Lovell's wife (my sister) on September 10, 2004 (as shown by Mr. Peloso's sworn affidavit attached as Exhibit C), and saw Mr. Lovell drive up as Nicholas F. Peloso was leaving the premises after that delivery. Regarding sending it via facsimile, I attempted to send the letter but the facsimile was unsuccessful at the number I

thought was his current facsimile. In any case, I have not received any response from Mr. Lovell.

9. I was hoping that Mr. Lovell would have reconciled with me (he chose the separation), and would be able to talk with me but time (for the PTO deadline) has run out. Mr. Lovell knew that time was running out but never contacted me.
10. As described above, I have made diligent efforts to obtain instructions from my co-inventor, Keith Lovell, regarding filing the aforementioned Election Requirement and responding to same. Mr. Lovell has not responded or advised of his position regarding same.
11. Based on the foregoing, and in order to prevent the present application from going abandoned, I requested that Mr. Holland's firm prepare and file a response to the Election Requirement.

I declare under penalty of perjury that the foregoing is true and correct.

Date: 9/20/09

By: Tim Horwood
Tim P. Horwood

Application No.: Unknown
Filing Date: Herewith

PATENT
Client Code: HORWOOD.001A
Page 1

ASSIGNMENT

WHEREAS, We, Tim P. Horwood, a Canadian citizen, residing at 14733 Willow Creek Lane, Chino Hills, CA 91709, Keith W. Lovell, a United States citizen, residing at 8 Navajo Trail Lane, Pomona, CA 91766, and John E. Pope, a United States citizen, residing at 14300 Clinton Street, #4, Garden Grove, CA 92843, have invented certain new and useful improvements in a PORTABLE SPA for which we have executed an application for Letters Patent in the United States, on even date herewith;

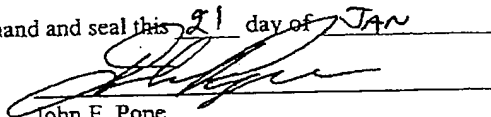
AND WHEREAS, Keith W. Lovell and Tim P. Horwood (hereinafter "ASSIGNEES"), desire to acquire the entire right, title, and interest in and to the said improvements and the said Application;

AND WHEREAS, John E. Pope desires to transfer his entire right, title and interest in and to the said improvements and the said Application to ASSIGNEES;

NOW, THEREFORE, in consideration of the sum of One Hundred Dollars (\$100.00) to me in hand paid, and other good and valuable consideration, the receipt of which is hereby acknowledged, I, John E. Pope, do hereby acknowledge that we have sold, assigned, transferred and set over, and by these presents do hereby sell, assign, transfer and set over, unto the said ASSIGNEES, their successors, legal representatives and assigns, the entire right, title, and interest throughout the world in, to and under the said improvements, and the said Application and all divisions, renewals and continuations thereof, and all Letters Patent of the United States which may be granted thereon and all reissues and extensions thereof, and all rights of priority under International Conventions and applications for Letters Patent which may hereafter be filed for said improvements in any country or countries foreign to the United States, and all Letters Patent which may be granted for said improvements in any country or countries foreign to the United States and all extensions, renewals and reissues thereof; and I hereby authorize and request the Commissioner of Patents of the United States, and any Official of any country or countries foreign to the United States, whose duty it is to issue patents on applications as aforesaid, to issue all Letters Patent for said improvements to the said ASSIGNEES, their successors, legal representatives and assigns, in accordance with the terms of this instrument.

AND I HEREBY covenant and agree that I will communicate to the said ASSIGNEES, their successors, legal representatives and assigns, any facts known to me respecting said improvements, and testify in any legal proceeding, sign all lawful papers, execute all divisional, continuing and reissue applications, make all rightful oaths and generally do everything possible to aid the said ASSIGNEES, their successors, legal representatives and assigns, to obtain and enforce proper patent protection for said improvements in all countries.

IN TESTIMONY WHEREOF, I hereunto set my hand and seal this 21 day of JAN 2000


John E. Pope

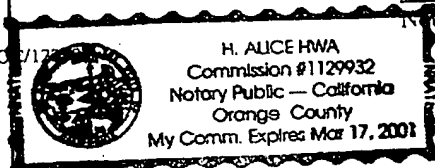
STATE OF CALIFORNIA
COUNTY OF ORANGE } ss.

On Jan. 21, 2000, before me, H. Alice Hwa, personally appeared John E. Pope personally known to me (or proved to me on the basis of satisfactory evidence) to be the person(s) whose name(s) is/are subscribed to the within instrument, and acknowledged to me that he executed the same in his authorized capacity(ies), and that by his signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.

WITNESS my hand and official seal.

[SEAL]

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H. Alice Hwa
Notary Signature

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Patent and Trademark Office
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OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APRIL 21, 2000

PTAS

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CRAIG S. SUMMERS
620 NEWPORT CENTER DRIVE
SIXTEENTH FLOOR
NEWPORT BEACH, CA 96220



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RECORDATION DATE: 01/26/2000

REEL/FRAME: 010553/6625
NUMBER OF PAGES: 2

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:
POPE, JOHN E.

DOC DATE: 01/21/2000

ASSIGNEE:
LOVELL, KEITH W.
8 NAVAJO TRAIL LANE
POMONA, CALIFORNIA 91766

NO DATES BOOKED
ATTORNEY'S SIGNATURE
INITIALS

ASSIGNEE:
HORWOOD, TIM P.
14733 WILLOW CREEK LANE
CHINO HILLS, CALIFORNIA 91709

SERIAL NUMBER: 09491361
PATENT NUMBER:

FILING DATE: 01/26/2000
ISSUE DATE:

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Lifesprings Spas

(909) 606 8923

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010553/0625 PAGE 2

ANTIONE ROYALL, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

Tim P. Horwood

14562 Central Ave. Chino, CA 91710 (909) 606-8884 Fax# (909) 606-8820

September 10, 2004

Mr. Keith Lovell
8 Navajo Trail
Phillips Ranch, CA 91766

SENT VIA HAND-DELIVERY 09.10.04
SENT VIA FAX 09.10.04

**RE: PENDING U.S. PAT. APPLICATION
SER. NO. 10/606, 605**

Dear Keith:

I hope all is well with you, Shirlee and the girls.

I am contacting you regarding our patent application. I understand that Craig Summers sent to you a copy of the Office Action received in March. I haven't heard from you in the many months since Craig's letter. Time is running out to respond and if something doesn't happen it will go abandoned. I don't want to abandon our patent application.

I have retained a new patent attorney, J. Mark Holland & Associates. He said he can answer the pending Office Action and I would like to have him do that. I want to know what you would like to do.

Due to the time constraints to draw up the response and any related papers, and the fact that I am very tied up next week, there really is no more time left for contemplation.

I feel that putting things aside regarding our relationship and the past is very important. With all the time, effort, money and heartache we and our families have put into this invention, it would be sad to abandon it. Let's both at least have a chance at making our patent coverage even stronger and more complete.

Please let me know within forty-eight hours of today's date (9/10/04) if you wish to abandon our patent application or you wish to answer it. If you want to continue to own one-half of this patent application, you will need to pay one-half of my fees (Attorney fees, filing fees, etc.).

Mr. Keith Lovell
September 10, 2004
Page Two

If you choose to hire your own Attorney please let me know. I will fax you correspondence to keep you apprised at what is going on with the patent.

Just for your information, if you do not respond within forty-eight hours of this official notice, I will be forced to answer the Office Action alone and I will pay all fees, thus taking full ownership of the new patent.

I await your response.

Sincerely,



Tim P. Horwood

cc: J. Mark Holland & Associates
3 Civic Plaza, Ste. 210
Newport Beach, CA 92660

AFFIDAVIT

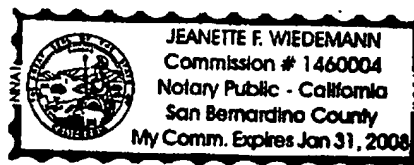
State of California
County of San Bernardino

I, Nicholas F. Peloso, hand-delivered to Mrs. Shirlee Lovell, a 2-page letter from Tim P. Horwood regarding Pending U.S. Patent Application, Ser. No. 10/606, 605. I hand-delivered this 2-page letter on September 10, 2004, at approx. 2:15 p.m., at address 8 Navajo Trail, Phillips Ranch, CA 91766.

Nicholas F. Peloso 9/20/04
Nicholas F. Peloso Date

Sworn and subscribed before me this 20th day of September
A.D. 2004.

Notary Jeanette F. Wiedemann Sept 20, 2004
Witness Date



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